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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/883,561	06/18/2001	Garry I. Holloway	WAT0119	1090

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EXAMINER

GART, MATTHEW S

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 09/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/883,561

Applicant(s)

HOLLOWAY, GARRY I.

Examiner

Matthew s Gart

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>9/28/2001</u> | 6) <input type="checkbox"/> Other: ____  |

## DETAILED ACTION

The preliminary amendment dated 6/18/2001 has been entered. Claims 1-20 are pending in the instant application.

### ***Claim Rejections - 35 USC §101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requires of this title.

**Claims 1-7 and 16-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

Referring to claims 1-7 and 16-20. The invention as recited in the claims is merely an abstract idea that is not within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter.

Claims to computer-related inventions that are clearly nonstatutory fall into the same general categories as nonstatutory claims in other arts, namely natural phenomena such as magnetism, and abstract ideas or laws of nature, which constitute "descriptive material." Abstract ideas, *Warmerdam*, 33 F.3d at 1360, 31 USPQ2d at 1759, or the mere manipulation of abstract ideas, *Schrader*, 22 F.3d at 292-93, 30 USPQ2d at 1457-58, are not patentable. Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." In this

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context, "functional descriptive material" consists of data structures and computer programs that impart functionality when employed as a computer component.

Nonfunctional descriptive material" includes but is not limited to music, literary works and a compilation or mere arrangement of data. Both types of "descriptive material" are nonstatutory when claimed as descriptive material per se. Warmerdam, 33 F.3d at 1360, 31 USPQ2d at 1759.

The Examiner notes, claims 1-7 fail to recite any technology within the claims. Claims 1-7 recite a method of providing a user with a gem assessment. When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1-20 are rejected under 35 U.S.C. 102(e) as being anticipated by  
Malnekoff U.S. Patent No. 6,304,853.**

Referring to claim 1. Malnekoff discloses in an online environment (Malnekoff: column 2, lines 31-37), a method of providing a user with a gem assessment (Malnekoff: Figure 4), the method including the steps of:

- Receiving a plurality of proportional parameter values from the user relating to the proportions of the gem (Malnekoff: Figure 4, “**102**”);
- Obtaining a plurality of aesthetic parameter values based upon the received proportional parameter values (Malnekoff: column 4, lines 36-45); and
- Providing a gem rating based upon the plurality of aesthetic parameter values (Malnekoff: column 4, lines 36-45, “The processor device **14** then uses the baseline price estimate and the adjustment factor to generate a pricing estimate **116**”).

Referring to claim 2. Malnekoff further discloses a method of claim 1 wherein the parameter values at least include a depth percentage, table percentage, crown angle or percentage, pavilion angle or percentage, culet percentage and girdle thickness (Malnekoff: column 4, line 58 to column 5, line 22).

The Examiner notes, even though Malnekoff discloses all of the limitations of claim 2 as indicated supra, the parameter values are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F. 2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983).

Referring to claim 3. Malnekoff further discloses a method of claim 1 wherein the aesthetic parameters include brilliance, fire, scintillation and diameter spread (Malnekoff: column 4, lines 25-35).

The Examiner notes, even though Malnekoff discloses all of the limitations of claim 3 as indicated supra, the aesthetic parameters are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F. 2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983).

Referring to claim 4. Malnekoff further discloses a method of claim 3 wherein the aesthetic parameters further include at least one of the following: (i) vertical spread; (ii) table size; (iii) girdle thickness; (iv) culet size; (v) half facets; (vi) symmetry; (vii) polish (Malnekoff: claim 14).

The Examiner notes, even though Malnekoff discloses all of the limitations of claim 4 as indicated supra, the aesthetic parameters are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F. 2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983).

Referring to claim 5. Malnekoff further discloses a method of claim 1 wherein the gem rating is a numerical value relating to the aesthetic beauty of the gem (Malnekoff:

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column 4, lines 36-45, "The processor device **14** then uses the baseline price estimate and the adjustment factor to generate a pricing estimate **116**).

Referring to claim 6. Malnekoff further discloses a method of claim 1 wherein a description of the gem's visual appearance is also provided based upon the determined aesthetic parameters (Malnekoff: column 5, lines 20-47).

Referring to claim 7. Malnekoff further discloses a method according to claim 1 wherein the gem being assessed is a diamond (Malnekoff: column 5, lines 27-33).

Referring to claims 8-15. Claims 8-15 are rejected under the same rationale as set forth above in claims 1-7.

Referring to claims 16-20. Claims 16-20 are rejected under the same rationale as set forth above in claim 7.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Iwayama, U.S. Patent No. 6,556,883 B2, April 29, 2003, discloses performance value determination system and method.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew s Gart whose telephone number is 703-305-5355. The examiner can normally be reached on 8:30AM to 5:00PM m-f.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 703-308-1344. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Patent Examiner

MSG

September 7, 2004